

REMARKS

Applicants thank Examiner Gross and Supervisory Patent Examiner Low for their time and consideration of the present application during the telephonic interview of January 11, 2010 with the undersigned.

During the interview, the Examiners explained that they considered the Envelope Soleau submitted January 9, 2008 to suggest simultaneous conception and reduction to practice. For this reason, the Examiners believed that the declarations filed September 24, 2009 should identify the inventors as those involved in both conception and reduction to practice.

It was proposed that the undersigned forward a draft copy of a modified declaration prior to filing a response to confirm that the required language is provided. Examiner Gross confirmed that the declaration provided in the appendix would be sufficient to identify the named inventors as those who conceived and reduced to practice the subject matter common to the Envelope Soleau and the claimed invention during the telephonic interview of February 25, 2010.

This application is now believed to be in condition for allowance.

Status of the Claims

Claims 1, 2, 4, 7-15, and 19 remain pending in the application.

**Claim Rejections-35 USC §102**

Claims 1, 2, 4, 7-15, and 19 stand rejected under 35 U.S.C. §102(f) because applicants allegedly did not invent the claimed subject matter. This rejection is respectfully traversed.

The position of the Official Action was that the Enveloppe Soleau, for which a verified English translation was filed with the amendment of January 9, 2008, indicated two co-authors, i.e., Pascal JANVIER and Isa BENITEZ, who are not listed as named inventors of the claimed invention.

A newly executed Declaration Under Rule 132 has been provided in the Appendix of this response. This declaration was not presented earlier because the Examiner has taken a new position with respect to the Enveloppe Soleau.

The new position was that the Enveloppe Soleau represents *simultaneous* conception and reduction to practice had not been raised. Although declaration filed March 31, 2009 referred to conception, the subsequent Official Action of June 24, 2009 did not object to the declaration for referring to conception only. Instead, the Official Action of June 24, 2009 objected to the declaration for including only one inventor as the declarant.

The Examiner's attention is respectfully directed to the appendix of this response. The named inventors of the present application Charles TELLIER, Muriel PIPELIER, Didier

DUBREUIL, Bruno BUJOLI and Daniel TALHAM all confirm that they did conceive and reduce to practice the subject matter as claimed.

Therefore, the Enveloppe Soleau does not qualify as prior art under 35 U.S.C. 102(f), and withdrawal of the rejection is respectfully requested.

**Claim Rejections-35 USC §103**

Claims 1, 2, 4, 7-15, and 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over AGRAWAL et al. WO 2003/046508 A2 ("AGRAWAL") in view of PETRUSKA et al. 1998 ("PETRUSKA") and LOCKHART et al. US 5,556,752, and further in view of GAGNA et al. US 6,936,461. This rejection is respectfully traversed for the reasons below.

The present application claims priority to French application No. 02/09456 filed July 25, 2002.

Based on this priority date, AGRAWAL would appear to qualify as prior art with a 102(e) date of November 9, 2001 and GAGNA would appear to qualify as prior art with a 102(e) date of July 31, 2001.

However, neither AGRAWAL nor GAGNA qualify as prior art.

As discussed above relative to the anticipation rejection, the named inventors, Charles TELLIER, Muriel PIPELIER, Didier DUBREUIL, Bruno BUJOLI and Daniel TALHAM conceived and reduced to practice the subject matter in claims 1, 2, 4, 7-15 and

19 and the subject matter shared by these claims and the Enveloppe Soleau.

In the Declaration Under Rule 131 filed January 9, 2008 by Bruno BUJOLI, one of the named inventors, it was stated the claimed invention of the present application was completed prior to July 31, 2001. Specifically, the Enveloppe Soleau, dated April 30, 2001, was filed with the French Patent Office (INPI) on May 17, 2001 to register a date for the claimed invention. In two subsequent Declarations Under Rule 132 filed September 9, 2009 the remaining inventors (Charles TELLIER, Muriel PIPELIER, Didier DUBREUIL, and Daniel TALHAM) confirmed that they authorized Bruno BUJOLI to make this statement (See item 2 of these declarations).

Accordingly, in view of the facts set forth in the declarations, AGRAWAL and GAGNA fail to qualify as prior art with respect to the claimed invention.

The remaining applied publications PETRUSKA and LOCKHART fail to render obvious the claimed invention.

PETRUSKA relates to a film of Langmuir-Blodgett type comprising metal (zirconium) phosphonates. PETRUSKA describes a solid support the surface of which is covered with zirconium by means of phosphonic acid (spacer) (see scheme 1, page 132). However, PETRUSKA fails to describe the bonding of a biopolymer with said solid support.

LOCKHART describes solid supports  $Y - L^1 - X^1 - L^2 - X^2$  (see column 8, line 30), wherein Y represents said solid support,

$L^1$  represents an optional spacer,  $L^2$  is a linking group having sufficient length such that  $X^1$  and  $X^2$  form a double-stranded oligonucleotide, and  $X^1$  and  $X^2$  represent a pair of complementary oligonucleotides. However, LOCKHART fails to disclose or suggest solid supports having a surface of which is covered with a metal. Furthermore, the biopolymer of LOCKHART ( $X^1$  and  $X^2$  oligonucleotides) is linked to the solid support by means of a hydroxyl group (column 9, lines 43-45). Thus, LOCKHART fails to disclose an ionocovalent bonding between the metal surface of a solid support and the phosphate group of a biopolymer.

Thus, it would have been unobvious for one of ordinary skill in the art to even approach claimed biochip in view of PETRUSKA and LOCKHART, as there was no recognition of ionocovalent bonding between a metal surface and a phosphate group of a biopolymer.

Therefore, the proposed combination does not render obvious any of claims 1, 2, 4, 7-15 and 19, and withdrawal of the rejection is respectfully requested.

**Conclusion**

In view of the foregoing remarks and accompanying declaration, this application is in condition for allowance at the time of the next Official Action. Allowance and passage to issue on that basis is respectfully requested.

Should there be any matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

The Commissioner is hereby authorized in this, concurrent, and future submissions, to charge any deficiency or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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APPENDIX:

- Declaration Under Rule 132 signed by Charles TELLIER, Muriel PIPELIER, Didier DUBREUIL, Bruno BUJOLI and Daniel TALHAM.